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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,101	12/23/2003	Kenta Oonishi	117960	8011

25944 7590 10/17/2005

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EXAMINER
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CHIN, GARY

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/743,101	OONISHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gary Chin	3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/8/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

*CW*

**DETAILED ACTION**

1. The restriction requirement dated 7/6/05 is hereby withdrawn in view of applicants' amendment filed 8/5/05.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 12-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 12-15, the claimed program per se is not statutory subject matter under 35 USC 101. It appears that claims 12-15 would be statutory if they are rewritten to direct to a navigation system that uses a program (instead of a program as currently recited) to search for a route to a destination based on stored map data that provides navigation guidance to the destination along the route.

***Claim Rejections - 35 USC § 112***

4. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1, 12 and 16, as disclosed in the instant specification, the essential feature of the invention is to search a recommended second route that would exclude the unsuitable road, that is road with a curve or a road having a greater change in altitude than a predetermined value from the first route (a mountain road). However, there is no clear recitation in the body of these claims as to how the so-called "changed search cost" can provide such exclusion in the

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recommended second route. Actually, there is no real distinction between the first and second routes as currently recited in these claims. Further, the phrase “for any detected road” should be “for the detected road” in order to avoid the antecedent basis problem (see “detects a road having a greater change in altitude”).

As per claims 5-9, 13 and 17, there is no clear recitation in these claims as to how the “search cost” as recited in their respective parent claims is related to “a length” of the first and second routes.

Claims that have not been specifically indicated are rejected for incorporating the above errors from their respective parent claims by dependency.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 4, 11-12, 15-16 and 19-25 as best understood in view of the aforementioned 112 deficiencies are rejected under 35 U.S.C. 102(b) as being anticipated by Kozak (patent no. 6415226).

As per claims 1-2, 11-12, 15-16 and 19-25, figures 1, 3, 5 and 6A-6B of the Kozak reference clearly disclose the claimed navigation system, program and storage medium that searches for a route to a destination based on stored map data that provides navigation guidance to the destination along the route including searching for a first route based on a search cost, detecting a curve and/or a road having a change in altitude (col. 3, lines 45-46, 53-56 and fig.

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6A, item 5) and search a solution route or second route as a recommended route based on the changed search cost (col. 10, lines 56- col. 11, lines 1-19).

As per claim 4, the claimed road data including the curve information is taught in col. 4, lines 13-15 of the Kozak reference.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 3, 5-10, 13-14 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozak (patent no. 6415226).

As per claims 3, 10, 14 and 18, it is noted that the curve information in Kozak is derived from the map data and not the number of nodes per unit length as claimed. However, such curve detection technique is well known in the navigation art and would have been readily apparent for one skilled in the art.

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As per claims 5-9, 13 and 17, as admitted by applicant on page 1, section 0004 of the instant specification, the claimed selection of a recommended route based on the length of a route is well known in the art. Hence, it would have been obvious for a person having ordinary skill in the art to incorporate such well-known selection criterion into the Kozak system based on applicants' own admission.

10. The additional references are cited to show the related systems. Applicant(s) should consider them carefully when responding to the current office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Chin whose telephone number is (571) 272-6959. The examiner can normally be reached on Monday-Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached on (571) 272-6956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**GARY CHIN**  
**PRIMARY EXAMINER**